

REMARKS

## OVERVIEW

Claims 5-9, 11-12, and 15 are pending in this application. Claims 1-4, 10, 13-14 have been cancelled. Claims 5 and 12 have been amended. The present response is an earnest effort to place all claims in proper form for immediate allowance. Reconsideration and passage to issuance are respectfully requested.

CLARIFICATIONS REGARDING TRAVERSAL OF ELECTION/ RESTRICTION  
REQUIREMENT OF PAPER NO. 13

The Examiner has indicated that the Examiner believes that the Applicant's explanation that claims 12, 13 and 15 are readable on the embodiments of Figures 5-8 to be confusing (Office Action, page 2, numbered paragraph 1). Claim 12 has been amended, and it is respectfully submitted that any prior confusion is moot as claims 12-15 are no longer readable on the embodiment of Figures 5-8 as claim 12 now require "the clip having an open portion facing the heel end." As no pending claims are generic, the withdrawn claims (1-4) have now been cancelled.

## ISSUES UNDER 35 U.S.C. § 112

Claims 5-10 and 12-15 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Office Action, page 2, numbered paragraph 3). In particular, the Examiner indicates that "the original disclosure fails to teach the protective pocket having no opening for inserting the head of the golf club except through the partially open collar. Fig. 1 shows the opening extends beyond the collar and into the upper portion. This is a new matter rejection." (Office Action, page 2, numbered paragraph 3). The

Applicant has amended claim 5 to remove the limitation of "the protective pocket having no opening for inserting the head of the golf club except through the partially open collar."

Therefore, it is respectfully submitted that these rejections with respect to claims 5-10 have been remedied. It is also noted that claim 10 has been cancelled, thereby mooting that rejection.

With respect to claim 12, the limitation of "the upper portion for enclosing the club head without an opening for insertion or removal of the club head except through the lower portion" has been removed. Therefore, it is respectfully submitted that this rejection to claims 12-15 should be withdrawn. Moreover, claims 13-14 have been cancelled, thereby mooting those rejections.

The Examiner also indicates it is unclear whether claims 12, 13, and 15 are readable on the embodiment of Figures 5-8. The Applicant has amended claim 12 to require "the clip having an open portion facing the heel end." Due to the addition of this limitation, claim 12 is not readable on the embodiment of Figures 5-8. Claim 13 is cancelled. Claim 15 depends from claim 12. It is therefore respectfully submitted that this amendment to claim 12 moots the Examiner's concerns with respect to clarity. It is further noted that the upper portion is defined to include a pocket for retaining the golf club head while the lower portion extends downwardly from the upper portion.

#### ISSUES UNDER 35 U.S.C. § 102

Claims 12 and 15 have been rejected under 35 U.S.C. § 102(e) as being anticipated by either U. S. Patent No. 6,321,805 to Suggs or U. S. Patent No. 6,065,516 to Chang. Claim 12 now requires "the lower portion having a clip for securing the cover to the golf club; the clip having an open portion facing the heel end." This limitation was previously found in now

cancelled claims 13 and 15. Neither Suggs nor Chang disclose this limitation. Therefore, these rejections must be withdrawn.

Claims 12, 13, and 15 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U. S. Patent No. 5,944,081 to Aldcroft et al. Aldcroft et al. discloses an iron cover with an opening towards the front or toe end of the head cover (see e.g., Fig. 1). Aldcroft et al. does not disclose a "clip having an open portion facing the heel end." This limitation now incorporated into claim 12 was previously found in now cancelled claim 14. As Aldcroft et al does not disclose this limitation, these rejections must be withdrawn.

#### ISSUES UNDER 35 U.S.C. § 103

Claim 11 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 4,898,222 to Gaffney in view of U. S. Patent No. 5,547,193 to Sander. The Examiner recognizes that Gaffney does not disclose a resilient clip (Office Action, page 3, numbered paragraph 7). The Examiner has failed to make a *prima facie* case of obviousness based on this combination. For example, claim 11 requires "the clip oriented to provide an opening towards a heel end of the protective pocket." Sander discloses a clip 22. Sander does not disclose orienting a clip "to provide an opening towards a heel end of the protective pocket." Moreover, it would not have been obvious to use a clip in Gaffney because Gaffney discloses that the edges adjacent the shaft are pressed together to secure the cover around the shaft (Abstract). Gaffney does not disclose that any portion of the shaft is left exposed as would be the case with a clip. Nor does Gaffney disclose any structure for fastening a head cover directly to a shaft—instead, Gaffney only discloses fastening one side of the head cover to itself—a very different type of configuration than a clip. Therefore, the clip of the present invention is of a different character than the fastener of Gaffney. It is further noted that in at least one embodiment of Gaffney (see

e.g., Figure 7) that the protective cover extends significantly down the shaft. It would not appear that a clip would be sufficient to fully secure the cover to the shaft of the club in this embodiment of Gaffney. Therefore, this is further evidence that there is no motivation or suggestion to combine Gaffney with a clip. Therefore, it is respectfully submitted that this rejection to claim 11 should be withdrawn.

Claims 5, 6, 8-11 and 13-15 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U. S. Patent No. 6,321,805 to Suggs in view of Sander. Claim 5 has been amended to require "a pull tab affixed to the heel end of the protective pocket for removing a golf club head cover from the club." Sander does not disclose this pull tab affixed to the heel end. Suggs does not disclose this pull tab affixed to the heel end. It is further noted that the structural configuration of the golf club head cover is significantly different than either that of Sander or Suggs, such that the golf club head cover is removed in a different manner. The placement of the pull tab on the heel end of the protective pocket is consistent with the direction of force to be applied to remove the pull cover, but is inconsistent with the manner of removing the pull cover of Suggs. Therefore, it is respectfully submitted that this rejection to claim 5 should be withdrawn. As claim 6, 8 and 9 depend from claim 5, it is respectfully submitted that these rejections should be withdrawn. As claim 10 has been cancelled, this rejection is moot.

With respect to claim 11, the Examiner recognizes that Suggs does not disclose a clip (Office Action, page 4, numbered paragraph 8). Once again, the Examiner relies on Sander to disclose a clip. The Examiner does not point to any specific portion of either reference for providing a proper motivation or suggestion to combine the references. Sanders and Suggs have significant structural differences. Suggs relies upon a V-shaped slot (abstract; Figure 4). This V-shaped slot structure is not consistent with using a clip. The opposite sides of the V of the cover

would need to be fastened together. This is a very different type of structure than clipping a golf club head cover to a shaft as in Suggs portions of the golf club head cover are fastened together instead of clipping the club head cover directly to the shaft. Therefore, it is respectfully that this rejection to claim 11 should be withdrawn.

Therefore, this rejection should be withdrawn.

Claims 13 and 14 have been cancelled, thereby mooted these rejections. Claim 15 depends from claim 12 which has been amended. Claim 12 requires "the clip having an open portion facing the heel." For the reasons previously expressed, the combination of Suggs and Sander is deficient, therefore it is respectfully submitted that this rejection should also be withdrawn.

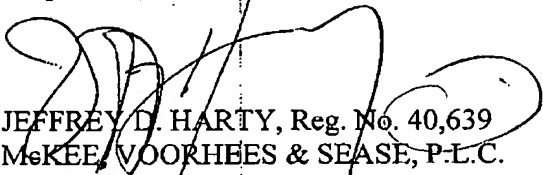
Claim 7 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over the Suggs rejection and further in view of U. S. Patent No. 4,378,832 to Thompson. Claim 7 depends from claim 5 which has been amended to include "a pull tab affixed to the heel end of the protective pocket for removing the golf club head cover from the club." It is respectfully submitted that neither Suggs nor Thomson disclose this limitation. Therefore these rejections should also be withdrawn.

CONCLUSION

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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